

REMARKS

Claims 1-112, 116-117, and 136-152 are pending in this application. Claims 1-112, 116-117, and 136-152 stand rejected. In light of the remarks set forth below, Applicants respectfully requests reconsideration of the pending claims and submits that each of the pending claims is in immediate condition for allowance.

Applicants request the Examiner acknowledge Applicants' claim for priority to provisional patent application No. 60/196,003.

Applicants further request that the Examiner acknowledge the Request To Restart Time For Reply filed March 17, 2004 and restart the date for reply to begin running from March 12, 2004. As set forth in that communication, the Office Action mailed on February 18, 2004, failed to include the FDIC reference listed on the PTO-892 form. Applicants' representative told the Examiner of this deficiency during a telephonic interview on March 12, 2004, within one month of the mailing of the Action. Because Applicants' representative informed the Office of the defect in the Office Action within one month of the mailing date, the Office, according to the Rules set forth in M.P.E.P. 710.06, must restart the previously set period for reply to run from the date error is corrected, March 12, 2004.

Because the defect was corrected on March 12, 2004, Applicants request that the new period to respond be reset to begin on March 12, 2004. Additionally, Applicants request a refund of \$310.00 for filing a three month extension of time when only a two month extension was required due to the restarting of the time to respond.

Claims 1-112, 116-17, and 136-152 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over State Street (1997) in view of Poindexter (U.S. Patent No. 6,338,074) and further in view of Notani (U.S. Patent No. 6,442,528). Applicants respectfully request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j) (emphasis added). A reference can only be used for what it clearly discloses or suggests. See In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the prior art references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

To be a prior art reference, the reference must be a printed publication and accessible to the public before the filing date of the application. In re Hall, 228 U.S.P.Q. 453 (Fed. Cir. 1986); M.P.E.P. § 2128. M.P.E.P. § 2128.01. A publication that does not include a publication date (or a retrieval date) cannot be relied upon as prior art under 35 U.S.C. § 102(a) or (b) although it may be used to show the state of the art at or around the time the invention was made. See, M.P.E.P. §§ 2124, 2128 (emphasis added). In the present case there has been no showing that the undated State Street reference was accessible to the public prior to August 3, 2000.

Applicants submit that the Office Action has not properly established the State Street document as prior art. The Examiner has taken the position that the State Street web pages can be dated using a completely unrelated FDIC Letter, that is dated December 13, 1999. Applicant's strongly disagree with this position. The cited State Street documents themselves have no publication date and do not refer to the FDIC letter. Likewise, the FDIC letter does not reference the State Street reference. The FDIC Letter cannot be relied upon to date the web pages or the disclosure therein.

The Office Action asserts that the publication date of the State Street material is the date that the FDIC released a letter for guidance on Asset Securitization. The FDIC Letter merely establishes that, at least by December 13, 1999, the FDIC had provided guidance regarding asset securitization. The Examiner has used this date in combination with the self-serving statement from the State Street Web site that "[s]ince inception of the U.S. securitization market, we have shown a commitment to the market by successfully serving as administrator, credit enhancer, placement agent, investor and trustee" to date the Web page as of December 13, 1999.

Applicants hereby admit that the practice of asset securitization has existed in the United States since the early 1970s. Using the logic in the Office Action, the State Street web pages should therefore be considered prior art as of the 1970s. Clearly, this is absurd. The fact that State Street claims they have been involved in asset securitization since the 1970s does not establish that State Street's web pages were published in the 1970s. Furthermore, merely being involved in asset

securitization activities does not in any way establish State Street had a computerized method for work flow management for a trustee handling a plurality of securitization transactions or that such a system was discussed on the State Street Web site.

The Office Action has provided no reasonable evidence whatsoever that the State Street reference was actually available as of the filing of the present Application as specifically required by the MPEP. As such, Applicants assert that the State Street reference is not prior art and therefore may not be used as a reference.

As the State Street is not a prior art reference as against the present application, withdrawal of the rejections based on State Street is respectfully requested.

Because State Street is not a prior art reference, the remaining references, Poindexter and Notani, fail to disclose all of the limitations in Applicants' pending claims. Poindexter and Notani were not cited to disclose a computerized method for workflow management for a trustee handling a plurality of securitization transactions but for deficiencies noted by the Examiner in State Street. Whether or not Poindexter and Notani disclose the limitations for which they are cited is irrelevant as the Examiner has failed to cite a valid reference disclosing a computerized method for workflow management for a trustee handling a plurality of securitization transactions. As such, Applicants respectfully request reconsideration and withdrawal of the pending rejection.

Applicants have responded to all of the rejections and objections recited in

the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: July 19, 2004

Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas - 41st Floor
New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant

IRB